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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,413	11/21/2000	Owen H. Decker	FA0972 US NA	6493

23906 7590 01/21/2003

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EXAMINER	
SHOSHO, CALLIE E	
ART UNIT	PAPER NUMBER
1714	9

DATE MAILED: 01/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/717,413	Applicant(s) DECKER ET AL.	
	Examiner Callie E. Shosho	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12/26/02* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2 and 5-7* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2 and 5-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. All outstanding rejections except for those described below are overcome by applicant's amendment filed 12/26/02, which has been entered.

Upon updating the searches, a new reference came to the attention of the examiner, namely, Rigosi et al. (U.S. 6,455,630) which was issued after the mailing date of the previous office action. In light of the new grounds of rejection utilizing Rigosi et al. as set forth in paragraph 7 below, the finality of the previous office action (mailed 9/20/02, Paper No. 7), has been withdrawn, and thus, the following action is non-final.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-2 and 5-7 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1 and 5 have been amended to recite that "gloss value is decreased by at least twice as much as a coating composition comprising 0 wt.% of spheroidal particles and "flow parameters are decreased by no more than 1.5 times as much as the coating composition comprising 0 wt.% of spheroidal particles". It is the examiner's position that each phrase fails to satisfy the written description requirement under the cited statute since there does not appear to

be a written description requirement of either phrase in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163.

As support for the recitation of the above phrases, applicants point to Table 9 of the present specification. In Table 9, when comparing comparative example 1, i.e. comprising no microspheres, with inventive example 4, i.e. comprising microspheres within the scope of the present claims, it is seen that the flow parameter of the inventive example is 1.5 times less than the flow parameter of comparative example 1 while the gloss of inventive example 4 is approximately 2.6 times less than the gloss of comparative example 1. Similarly, for the remaining three examples of Table 9, the gloss of examples 15, 17, and 19 is 2.1 times, 2.7 times, and 3.2 times lower, respectively, than the gloss of examples 14, 16, and 18 while the flow parameter is the same, 2.6 times, and 1.2 times less than flow parameter of examples 14, 16, and 18.

Thus, while there is support for the recitation that the gloss of the presently claimed powder coating composition is 2.6 times (or 2.1 times or 2.7 times or 3.2 times) less than the gloss of coating composition comprising 0 wt.% of spheroidal particles and the flow parameter of the presently claimed powder coating composition is 1.5 times less than (or then same as or 2.6 times less than or 1.2 times less than) the flow parameter of coating composition comprising 0 wt.% of spheroidal particles, there is no support to recite that the gloss is "decreased by at least twice as much" or that the "flow parameter is decreased by no more than 1.5 times as much". That is, in light of the claim language, i.e. "at least" or "no more than", the recitation in the claims as presently amended encompasses embodiments wherein the gloss of the present composition is decreased by at least 3 times, 5 times, 10 times etc. while the flow parameter is

decreased by no more than 1.4 times, 1.3 times, 1.1 times, etc, for which there is no support in the specification as originally filed. There is only support for each of the specific embodiments as disclosed in Table 9 and discussed above.

With respect to the phrase "flow parameters are decreased by no more than 1.5 times as much as the coating composition comprising 0 wt.% of spheroidal particles", it is the examiner's position that this phrase additionally fails to satisfy the written description requirement under the cited statute given that there is no written description requirement of "flow parameters" in the application as originally filed.

That is, in the present specification including the examples, the applicants discuss only one type of flow parameter, i.e. Inclined Plate Flow at 375^0 F (see Tables 2-3). There is no support that all different types of flow parameters are "decreased by no more than 1.5 times as much coating composition comprising 0 wt.% of spheroidal particles". There is only support for the recitation of the one specific type of flow parameter set forth in the present specification.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-2 and 5-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) Claims 1 and 5 recite that the powder coating composition has "low gloss value and good flow parameters". The scope of the claims is confusing because it is not clear what is meant

by each phrase. What values of gloss are considered low? How and when are the flow properties determined to be "good". What is meant by "good"? What does the phrase "flow parameters" encompass? Clarification is requested.

(b) Claims 1 and 5 each recite" gloss value is decreased by at least twice as much as a coating composition comprising 0 wt.% of spheroidal particles and "flow parameters are decreased by no more than 1.5 times as much as the coating composition comprising 0 wt.% of spheroidal particles". The scope of each of the claims is confusing because it is not clear what is meant by these phrases. For instance, how can the gloss values be "decreased" by "at least twice as much" as the gloss value of coating composition comprising 0 wt.% spherical particles? Does this phrase mean, for instance, that the gloss of the present composition is at least 2 times less than the gloss of coating composition comprising 0 wt.% spherical particles? Clarification is requested.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-2 and 5-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Rigosi et al. (U.S. 6,455,630).

Rigosi et al. disclose powder coating composition comprising polyolefin including polypropylene and polyethyelene and 1-40% glass microsphere which has diameter of 30-70 μm. There is also disclosed a method for adding microsphere to powder coating composition (col.1, lines 6-7, col.2, lines 45-59, col.3, lines 3-38, col.4, lines 19-21, and col.7, lines 38-39).

Although there is no explicit disclosure of the median diameter of the microspheres given that the diameter of the microspheres ranges from 30-70 μm, i.e. maximum falls within 30-70 μm which overlaps value presently claimed, it is clear that the median diameter will inherently be greater than 10 μm as presently claimed.

Further, although there is no explicit disclosure regarding the gloss or the flow parameters, given that Rigosi et al. disclose powder coating composition comprising polyolefin and microsphere identical to that presently claimed, it is clear that the powder coating composition would inherently exhibit gloss and flow parameters identical to those presently claimed.

In light of the above, it is clear that Rigosi et al. anticipates the present claims.

8. Claims 5-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Muthiah et al. (U.S. 6,017,640) taken in view of the evidence in *Encyclopedia of Polymer Science and Engineering.*

Muthiah et al. disclose low gloss powder coating composition comprising resin including unsaturated polyester and polyacrylates and ceramic, hollow glass, or resin microsphere. There is also disclosed a method of reducing gloss by adding the microsphere to the powder coating composition (col.6, lines 13-16 and col.13, lines 53-55 and 62-63). Based on the ingredients present in the composition (see col.20, lines 23-37), it is calculated that the composition comprises 0.08-50% microsphere. Although there is no explicit disclosure of the median particle diameter and the maximum particle diameter of the ceramic or hollow glass microsphere, it is well known, as found in *Encyclopedia of Polymer Science and Engineering* that ceramic microspheres typically posses average particle size of 10-30 μm and maximum particle size of 5-60 μm (page 789) while hollow glass microspheres possess average particle size of 10-200 μm and average particle diameter of greater than 15 μm (pages 791-792).

In light of the above, it is clear that Muthiah et al. anticipate the present claims.

Response to Arguments

9. Applicants' arguments filed 12/26/02 have been fully considered but they are not persuasive.

Specifically, applicants argue that Muthiah et al. disclose laundry list of fillers with no disclosure or suggestion of which filler would produce composition with gloss and flow parameters as presently claimed.

However, it is noted that Muthiah et al. disclose that the fillers are used to "lower gloss". While there is no explicit disclosure of the diameter (maximum or median) of the filler, it is well

known as found in *Encyclopedia of Polymer Science and Engineering* that ceramic microspheres typically posses average particle size of 10-30 μm and maximum particle size of 5-60 μm (page 789) while hollow glass microspheres possess diameter of 10-200 μm and average particle diameter of greater than 15 μm (pages 791-792).

While it is agreed Muthiah et al. lists many other fillers, the fact remains that one of them is microspheres as presently claimed. Applicant's attention is drawn to MPEP 2131.02 (A) which states that "..when the species is clearly named, the species claim is anticipated no matter how many other species are additionally named". *Ex Parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990).

Given that the microspheres of Muthiah et al. possess diameter as presently claimed (in light of the evidence found in *Encyclopedia of Polymer Science and Engineering)*, it is clear that the powder composition of Muthiah et al., which also comprises thermoplastic polymer as presently claimed, would inherently possess gloss and flow parameters as presently claimed.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Callie E. Shosho
Examiner
Art Unit 1714

CS
January 15, 2003